



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE  
United States Patent and Trademark Office  
Address: COMMISSIONER OF PATENTS AND TRADEMARKS  
Washington, D.C. 20231  
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/139,386	08/25/1998	JOSEPH ALBERT MONFORTE	GETR.031-STA	5243

24961 7590 04/01/2003

HELLER EHRMAN WHITE & MCAULIFFE LLP  
4350 LA JOLLA VILLAGE DRIVE  
7TH FLOOR  
SAN DIEGO, CA 92122-1246

EXAMINER

TUNG, JOYCE

ART UNIT	PAPER NUMBER
----------	--------------

1637

DATE MAILED: 04/01/2003

30

Please find below and/or attached an Office communication concerning this application or proceeding.

# Advisory Action

Application No.

09/139,386

Applicant(s)

Monforte et al.

Examiner

Joyce Tung

Art Unit

1637

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

THE REPLY FILED Mar 3, 2003 FAILS TO PLACE THIS APPLICATION IN CONDITION FOR ALLOWANCE.

Therefore, further action by the applicant is required to avoid the abandonment of this application. A proper reply to a final rejection under 37 CFR 1.113 may only be either: (1) a timely filed amendment which places the application in condition for allowance; (2) a timely filed Notice of Appeal (with appeal fee); or (3) a timely filed Request for Continued Examination (RCE) in compliance with 37 CFR 1.114.

THE PERIOD FOR REPLY [check only a) or b)]

- a) ☒ The period for reply expires 3 months from the mailing date of the final rejection.
- b) ☐ The period for reply expires on: (1) the mailing date of this Advisory Action, or (2) the date set forth in the final rejection, whichever is later. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of the final rejection. ONLY CHECK THIS BOX WHEN THE FIRST REPLY WAS FILED WITHIN TWO MONTHS OF THE FINAL REJECTION. See MPEP 706.07(f).

Extensions of time may be obtained under 37 CFR 1.136(a). The date on which the petition under 37 CFR 1.136(a) and the appropriate extension fee have been filed is the date for purposes of determining the period of extension and the corresponding amount of the fee. The appropriate extension fee under 37 CFR 1.17(a) is calculated from: (1) the expiration date of the shortened statutory period for reply originally set in the final Office action; or (2) as set forth in (b) above, if checked. Any reply received by the Office later than three months after the mailing date of the final rejection, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

1. ☐ A Notice of Appeal was filed on \_\_\_\_\_. Appellant's Brief must be filed within the period set forth in 37 CFR 1.192(a), or any extension thereof (37 CFR 1.191(d)), to avoid dismissal of the appeal.
2. ☐ The proposed amendment(s) will not be entered because:
- (a) ☐ they raise new issues that would require further consideration and/or search (see NOTE below);
- (b) ☐ they raise the issue of new matter (see NOTE below);
- (c) ☐ they are not deemed to place the application in better form for appeal by materially reducing or simplifying the issues for appeal; and/or
- (d) ☐ they present additional claims without canceling a corresponding number of finally rejected claims.

NOTE: \_\_\_\_\_

3. ☐ Applicant's reply has overcome the following rejection(s): \_\_\_\_\_

4. ☐ Newly proposed or amended claim(s) \_\_\_\_\_ would be allowable if submitted in a separate, timely filed amendment canceling the non-allowable claim(s).

5. ☒ The a) ☐ affidavit, b) ☐ exhibit, or c) ☒ request for reconsideration has been considered but does NOT place the application in condition for allowance because:  
please see the attached.

6. ☐ The affidavit or exhibit will NOT be considered because it is not directed SOLELY to issues which were newly raised by the Examiner in the final rejection.

7. ☒ For purposes of Appeal, the proposed amendment(s) a) ☐ will not be entered or b) ☒ will be entered and an explanation of how the new or amended claims would be rejected is provided below or appended.

The status of the claim(s) is (or will be) as follows:

Claim(s) allowed: \_\_\_\_\_

Claim(s) objected to: \_\_\_\_\_

Claim(s) rejected: 1-21

Claim(s) withdrawn from consideration: \_\_\_\_\_

8. ☐ The proposed drawing correction filed on \_\_\_\_\_ is a) ☐ approved or b) ☐ disapproved by the Examiner.
9. ☐ Note the attached Information Disclosure Statement(s) (PTO-1449) Paper No(s). \_\_\_\_\_
10. ☐ Other: \_\_\_\_\_

Art Unit: 1637

1. The applicants After Final Response filed 3/3/2003 has been entered. Following the entry of the amendment, claims 1-21 are pending.
2. Claims 1-9, 11-14 and 20-21 remain rejected under 35 U.S.C. 102(e) as being anticipated by Koster (5,622,824).

The response argues that the teachings of Koster (5,622,824) teach an enzymatic digestion from the 3' end which is not chemical cleavage. The response further addresses that the term "chemical cleavable site" is used throughout the specification and the specification distinguishes between chemical and enzymatic reactions as listed, such as the chemical cleavable sites are 3' and 5' phosphorothioate, and 3' and 5' phosphoramidate (See pg. 39, line 26-27). Moreover the response argues that those of ordinary skill in the art distinguish between chemical and enzymatic cleavage. However, the claim read reasonably broad that the chemical cleavable site encompasses enzymatic cleavage because the enzymatic cleavage involves chemical reaction. Although the claims are interpreted in light of the specification, limitations from the specification are not read into the claims. Therefore the teachings of Koster teach the chemical cleavable site.

In addition, the 3' end of the primer is limited to a chemically cleavable site. The term "chemically cleavable site" can not be determined whether the chemically cleavable site is cleaved or not. Thus, the rejection is maintained.

Art Unit: 1637

3. Claims 15-19 remain rejected under 35 U.S.C. 103(a) as being unpatentable over Koster (5,622,824) as applied to claims 1-9, 11-14, and 20-21 above, and further in view of Koster (5,547,835).

The response argues that the references of Koster (5,622,824) and Koster (5,547,835) fail to teach a primer with a chemically cleavable site at the 3' end. The response repeats the argument that Koster et al. (5,622,824) do not teach chemical cleavable site. As recited above, the claims are reasonably read on the teachings of Koster (5,622,824) as set forth in section 2 above.

Nevertheless, Koster (5,547,835) <sup>does</sup> teaches many types of cleavage sites including a biotin/streptavidin system (see column 13, lines 15-31). Koster's listing of different cleavages would be different forms of chemical cleavages. Thus, the rejection is maintained.

4. Claim 10 remains rejected under 35 U.S.C. 103(a) as being unpatentable over Koster, (5,622,824) as applied to claims 1-9, 11-14, and 20-21 above, and further in view of Richards et al. (5,427,929).

The response argues that Richards et al. do not teach a nucleic acid primer having a 5' end and a 3' end including a first region containing the 5' end of the primer and an immobilization attachment site and a second region containing the 3' end of the primer and a chemically cleavable site. As recited previously in section 2, Koster, (5,622,824) do teach the chemically cleavable site at the 3' end of the primer.

Art Unit: 1637

Richard et al. teach eliminating as contaminants the nucleic acid containing cleavable sites and there is no motivation to combine the teachings of Richard et al. with the teachings of Koster, (5,622,824). However, Richards et al. disclose a method which involves a ligase chain reaction (See column 11, lines 2-9) and a primer comprising 3' end cleavable site (See column 16, lines 65-68 to column 17, 1-5). The reference of Richards et al. provides the teaching of applying a ligase as enzyme to extend a primer at 3' end. The motivation is that the method of Richards et al. is efficient and economical for reducing carryover contamination in an amplification procedure (See the Abstract). Thus, it would have been prima facie obvious to apply a ligase for the primer extension at 3' end. Therefore, the rejection is maintained.

5. No claims are allowable.

6. Any inquiries concerning this communication or earlier communications from the examiner should be directed to Joyce Tung whose telephone number is (703) 305-7112. The examiner can normally be reached on Monday-Friday from 8:00 AM-4:30 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Gary Benzion can be reached at (703) 308-1119 on Monday-Friday from 10:00 AM-6:00 PM.

Any inquiries of a general nature or relating to the status of this application should be directed to the Chemical/Matrix receptionist whose telephone number is (703) 308-0196.

7. Papers related to this application may be submitted to Group 1600 by facsimile transmission. Papers should be faxed to Art Unit 1637 via the PTO Fax Center located in Crystal

Application/Control Number: 09/139,386

Page 5

Art Unit: 1637

Mall 1 using (703) 305-3014 or 308-4242. The faxing of such papers must conform with the notice published in the Official Gazette, 1096 OG 30 (November 15, 1989).

Joyce Tung

*JT*  
March 25, 2003

*Jeffrey Siew*  
**JEFFREY SIEW**  
**PRIMARY EXAMINER**

*3/3/07*